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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,830	05/30/2001	Volker Lehmann	00 P 21957 US	6111
7590 08/02/2004			EXAMINER	
Altera Law Group, LLC 6500 City West Parkway Suite 100 Minneapolis, MN 55344-7704			QUAN, ELIZABETH S	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,830

Applicant(s)

LEHMANN, VOLKER

Examiner

Elizabeth Quan

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
7) ☒ Claim(s) 2 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 12/17/2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. DE 238444, DE 19700626, and EP 0296348 have been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected for the following reasons: Reference characters (105) and (404) do not represent structural elements. Reference character (210) has been labeled as both “room” and “space”. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: double-sided arrow accompanied by characters “G” and “H” in FIG. 3 and a reference character that resembles IV in FIG. 4. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 1743

Specification

4. The abstract of the disclosure is objected to because the original abstract now has the heading SUMMARY OF THE INVENTION. If Applicant intended that the original abstract be under the heading SUMMARY OF THE INVENTION, then the specification is objected to since there is no abstract. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities: The list of reference characters should be a part of the specification, and therefore, it should be placed before the page of claims. Additionally, it appears that Applicant submitted an amended specification that does not indicate where changes are made. For example, Examiner noticed that “pipette comb” is mentioned in the amended specification but not in the original specification. Applicant should submit an amended specification showing where changes are made by underlining to show additions and lining through to show deletions. Appropriate correction is required.

Claim Objections

6. Claim 2 is objected to because of the following informalities: “an” between “comprising” and “upper bodies” should be omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claims 1, 2, and 5-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 1743

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites “a plurality of pipettes above the wells”, “one analysis chip being in each case assigned to a well”, and “each analysis chip is arranged between its respective well and pipette.” These limitations are not supported by the instant specification. The first embodiment of the invention as shown in figs. 1-3 and described on page 5, line 20-page 7, line 25 discloses pipettes (202) above wells (102) but the intermediate plate (205) with chips (206) above the pipettes (202) not between the pipettes and wells. Even if one were to consider chamber (209) as the well, the pipettes (202) are not above the chamber (209). The second embodiment of the invention as shown in figs. 4-6 and described on page 7, line 27-page page 9, line 18 discloses that “[t]he second exemplary embodiment corresponds essentially to the first exemplary embodiment with the difference that no diaphragm 207 is needed” (page 7, lines 29 and 30). This statement indicates that everything remains the same, including the chamber (209) above intermediate plate (205) with chips (206), which is above pipettes (202), which is above wells (102), except for the absence of diaphragm (207). Instead, diaphragm (406) with pores (407) is positioned at the lower end (405) of the pipette (401). Therefore, the instant specification and drawings do not disclose “a plurality of pipettes above the wells” and “each analysis chip is arranged between its respective well and pipette.”

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 1, 2, and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1743

11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The claim recites elements, such as microtiter plate with a plurality of wells, plurality of pipettes, at least one pump, and analysis chips without structurally connecting them. How are they located in relation to each other?

12. Referring to claim 1, the language renders the claim indefinite. The claim is narrative, disorganized, and confusing. For example line 6 of the claim recites having analysis chips. What element has analysis chips? Does the pump have the analysis chip since the recitation of analysis chip follows immediately from the recitation of pump? It is unclear whether the limitation “which surface comes into contact with the analyte” refers to the surface of at least part of the liquid channels of the analysis chip.

13. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the analysis chips and further plate. It is unclear when parent claim 1 recites the analysis chips, dependent claim 2 recites a further plate, and dependent claim 5 recites that the analysis chips are arranged in the further plate. Claim 2 appears to recite an additional plate beside that of the intermediate plate with chips.

Response to Arguments

14. Applicant's arguments filed 5/14/2004 have been fully considered but they are not persuasive.

15. Applicant submits that the relevance of the non-English references is fully explained in the Background of the Invention of the specification. However, the Background of the Invention never mentions any of the non-English references cited in the Information Disclosure Statement.

16. Applicant submits that the drawings have been amended to correct deficiencies with changes in red and circled. Examiner does not know what changes in red and circled mean. Does it mean that what's in red and circled is deleted?

17. Applicant submits that the specification has been amended. However, Examiner notes that the corrections are not underlined, and therefore, it is unclear how the specification has been changed. It is also unclear whether the specification has an abstract since the original content of the abstract is under the heading SUMMARY OF THE INVENTION.

18. Applicant's arguments with respect to claims 1, 2, and 5-10 have been considered but are moot in view of the new ground(s) of rejection. The amended claims are not supported by the specification and drawings.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 1743

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (571) 272-1261. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth Quan
Examiner
Art Unit 1743

eq


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Supervisory Patent Examiner
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Application/Control Number: 09/867,830

Page 8

Art Unit: 1743